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REMARKS

This response is intended as a full and complete response to the Final Office Action mailed July 28, 2005.

Claims 1, 4-10, 12, and 22-33 are pending. Claims 1, 4-6, 8-10, and 12 are amended. Claims 2, 3, 11, and 13-21 are cancelled without prejudice or disclaimer. New claims 22-33 are added. The amendments contain no new matter and are fully supported by Applicants' original specification, including original claims and drawings. Applicants do not acquiesce to any characterizations in the Office Action of the art of record or the claimed subject matter. In addition, Applicants do not acquiesce to any statements in the Office Action as to the applicability of the art of record to the claims.

Applicants traverse all of the rejections in the Office Action and respectfully request reconsideration and passage of the claims to allowance for the following reasons.

Claims 1-10, 14-17, and 19-21 patentable over Coleman under §102

The Office Action rejected claims 1-10, 14-17 and 19-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,844,620 to Coleman et al. ("Coleman").

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation for the following reasons.

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Claim 1 recites, *inter alia*, "receiving, by a session manager from a terminal, a demand-cast request message for a particular region of a particular interactive program guide (IPG) page, the particular region being one of a plurality of regions, the regions including a guide region, a video region, an icon region, and a program description region, the particular IPG page being one of a plurality of IPG pages". Coleman fails to disclose at least these elements of claim 1.

By contrast, Coleman discloses a partial overlay display or a mini-guide and a full screen display of the program guide having different regions from the claimed invention. (Coleman, figures 6-10). Furthermore, Coleman fails to disclose the claimed demand-cast request message for a particular region of a particular IPG page. By contrast, Coleman discloses delivery data to the decoders in "preformatted blocks" to "provide relatively long messages" that are "easier to process at the encoder where the streams are created as well as easier and faster to process and store in the decoder". (Coleman, col. 8, lines 5-23). Coleman has taken an opposite approach from the claimed invention, because Coleman sends large messages rather than small, region-specific messages. The long messages in preformatted blocks of Coleman are clearly not the same as the claimed demand-cast request message for a particular region of a particular IPG page.

In addition, Coleman is directed to a different problem than the claimed invention. Coleman is generally directed to a program guide that can be easily switched by a user between a partial screen guide and a full-screen guide so that the guide can be used while a current program is continuously viewed. (Coleman, col. 1, lines 22-25). By contrast, the claimed invention is generally directed to messaging techniques that allow terminals to specifically designate the requested items of information (i.e., the specific regions of interest) for an IPG delivery system.

Therefore, claim 1 is patentable over Coleman under §102.

Claims 2 and 3 are cancelled.

Claims 4-10 and 12 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1, while adding additional elements. Therefore, claims 4-10 and 12 are also patentable over Coleman under §102.

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Claims 14-17 and 19-21 are cancelled.

Claim 22 recites, *inter alia*, "wherein the terminal-to-SM message for requesting one of the demand-cast streams identifies a particular region of a particular IPG page, the particular region being one of a plurality of regions, the regions including a guide region, a video region, an icon region, and a program description region, the particular IPG page being one of the IPG pages." For the same reasons given above with respect to claim 1, claim 19 is also patentable over Coleman under §102.

Claims 23-28 depend, directly or indirectly, from claim 22 and, thus, inherit the patentable subject matter of claim 22, while adding additional elements. Therefore, claims 23-28 are also patentable over Coleman under §102.

Claim 29 recites, *inter alia*, "partitioning, by a transport stream generator at a headend, a plurality of interactive program guide (IPG) pages into a plurality of regions, the regions including a guide region, a video region, an icon region, and a program description region". For the same reasons given above with respect to claim 1, claim 21 is also patentable over Coleman under §102.

Claims 30-33 depend, directly or indirectly, from claim 29 and, thus, inherit the patentable subject matter of claim 29, while adding additional elements. Therefore, claims 30-33 are also patentable over Coleman under §102.

Claim 13 patentable over Coleman under §103

The Office Action rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Coleman, taking Official Notice.

Claim 13 is cancelled.

Claims 11, 12, and 18 patentable over Coleman/Reynolds under §103

The Office Action rejected claims 11, 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Coleman in view of U.S. Patent No. 6,563,515 to Reynolds et al. ("Reynolds").

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in

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the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons.

Claims 11 and 18 are cancelled.

Claim 12 depends indirectly from claim 1 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements. Therefore, claim 12 is also patentable over Coleman under §102. In addition, claim 12 is patentable over the combination of Coleman and Reynolds under §103 for the following reasons.

Claim 1 recites, *inter alia*, "receiving, by a session manager from a terminal, a demand-cast request message for a particular region of a particular interactive program guide (IPG) page, the particular region being one of a plurality of regions, the regions including a guide region, a video region, an icon region, and a program description region, the particular IPG page being one of a plurality of IPG pages". The combination of Coleman and Reynolds fails to disclose at least these elements of claim 1. Coleman fails to disclose at least these elements as discussed above. Furthermore, Reynolds fails to disclose at least these elements of claim 1.

Reynolds is generally directed to an interactive television program guide system with a video window capability. (Reynolds, col. 2, lines 30-31, abstract). Reynolds describes display screens and methods for browsing the display screens, but fails to disclose any demand-cast request message, as claimed. Therefore, claim 12 is patentable over the combination of Coleman and Reynolds under §103.


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CONCLUSION

Thus, Applicants believe the claims are allowable for the above reasons. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea Nicholson or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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